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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,024	10/19/2001	Ercan E. Kuruoglu	110915	7124
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EXAMINER				
PAULA, CESAR B				
ART UNIT		PAPER NUMBER		
2178				
NOTIFICATION DATE		DELIVERY MODE		
04/17/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

09/982,024

Applicant(s)

KURUOGLU ET AL.

Examiner

CESAR B. PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, and 12-20 is/are rejected.
- 7) ☒ Claim(s) 4 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This action is responsive to the amendment filed on 11/1/2006.

This action is made Non-Final.

2. In the amendment, claims 1-20 are pending in the case. Claims 1, and 8 are independent claims.
3. The rejection of claims 1-6, 8-13, and 17-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Manly (Pat.# 3,714,636, 1/30/1973), in view of Ma et al, hereinafter Ma (Pat.# 5,909,805 B2, 6/21/2005, filed on 1/31/2001), have been withdrawn as necessitated by the newly discovered patent.
4. The rejection of claims 7, and 15-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Manly, in view of Bornstein et al, hereinafter Bornstein (Pat. # 6,751,779 B1, 6/15/04, filed on 3/20/2000), have been withdrawn as necessitated by the newly discovered patent.
5. The rejection of claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Manly, in view of Kupiec (Pat. # 6,533,822 B2, 3/18/03, filed on 1/30/98, as disclosed in pto-892 mailed on 8/25/04), has been withdrawn as necessitated by the newly discovered patent.

6. The rejection of claims 19-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Manly, in view of Lerner et al, hereinafter Lerner (Pat.# 6,859,909, 2/22/2005, filed on 3/7/2000) , have been withdrawn as necessitated by the newly discovered patent.

Drawings

7. The drawings filed on 10/19/2001 have been approved by the examiner.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 5, 8-12, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hull et al (Pat.# 6,671,684, 12/2003, filed on 9/1/2000).

Regarding independent claim 1, Hull discloses capturing or scanning highlighting annotations made on a document containing printed text—*capturing an original image of a document*. The annotations cause the annotated portion to be OCR'd, and the resulting text is stored in a repository for further use --*a processing device for detecting annotations made to the*

document prior to image capture, the annotations identifying lesser portions of text to be extracted from machine generated text of the original image of the document, the processing device determining the lesser portions of text of the document identified by the annotations to be extracted, and extracting only the lesser portions of text from the machine generated text from of the original image of the document, being identified by the detected annotations; a summary generator for generating a summary including only the extracted lesser portions of text from the machine generated text of the document. the summary condensed version of the machine generated text of the original image of the document and being generated as a separate electronic image document that is different from the original image-- (col. 6, lines 1-36).

Regarding claim 2, which depends on claim 1, Hull discloses capturing or scanning highlighting annotations made on a document containing printed text. The annotations cause the annotated portion to be OCR'd, and the resulting text is stored in a repository for further use (col. 6, lines 1-36)-- *generate a summary of the same document as that on which the annotations are detected.*

Regarding claim 3, which depends on claim 1, Hull teaches capturing or scanning highlighting annotations made on a document containing printed text. The annotations are used for retrieving a list of documents that contain the highlights, along with locations where the annotations occurred in those documents (col. 4, lines 9-29) —*generate a summary of a different document as that on which the annotations are detected.*

Regarding claim 5, which depends on claim 1, Hull discloses capturing or scanning highlighting annotations made on portions of a document containing printed text(col. 6, lines 1-36, Fig.4)—*image region associated with a detected annotation.*

Claims 8-10, and 12 are directed towards a method for implementing the system found in claims 1-3, and 5 respectively, and therefore are similarly rejected.

Regarding claim 17, which depends on claim 1, Hull teaches capturing or scanning highlighting annotations made on a document containing printed text. The annotations are used for retrieving a list of documents that contain the highlights, along with locations where the annotations occurred in those documents (col. 4, lines 9-29) — *extracting image maps of the original image of the document.*

Claim 18 is directed towards a method for implementing the steps found in claim 8, and therefore is similarly rejected.

Regarding claim 19, which depends on claim 1, Hull teaches capturing or scanning highlighting annotations made on a document containing printed text. The annotations are used for retrieving a list of documents that contain the highlights, along with locations where the annotations occurred in those documents (col. 4, lines 9-29)—*the summary includes at least one of a pointer and address indicating a place in the original image of the document from which the extracted portions are extracted.*

Claim 20 is directed towards a method for implementing the apparatus found in claim 19, and therefore is similarly rejected.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull.

Regarding claim 6, which depends on claim 5, Hull discloses capturing or scanning highlighting annotations made on portions of a document containing printed text(col. 6, lines 1-36, Fig.4)—*image region associated with a detected annotation, the image region represents a text portion in the document image to provide context for the identified annotation*. Hull fails to explicitly disclose: *the image region represents a sentence*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to capture an annotation image that represents a complete sentence of text, because of all the reasons found in Hull, including effective ways of accessing an electronic version of a document (col. 1, lines 53-57). This would provide the user with not just incomplete words, but also full sentences as desired and highlighted by the user.

Claim 13 is directed towards a method for implementing the system found in claim 6, and therefore is similarly rejected.

12. Claims 7, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull, in view of Bornstein et al, hereinafter Bornstein (Pat. # 6,751,779 B1, 6/15/04, filed on 3/20/2000).

Regarding claim 7, which depends on claim 1, Hull discloses capturing or scanning highlighting annotations made on portions of a document containing printed text(col. 6, lines 1-36, Fig.4). Hull fails to explicitly disclose: *a summary comprising portions which are selectively expandable to increase the information in that portion of the summary*. However, Bornstein teaches the increasing the sentences in a summary based upon the selection of a user-variable control (col.3, lines 16-40, col.4, lines 19-67, fig.3, 2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combined Hull, and Bornstein, because of all the reasons found in Bornstein, including allowing a user to rapidly review a document based on the level of interest on such document (col. 2, lines 17-30).

Regarding claim 15, which depends on claim 1, Hull discloses capturing or scanning highlighting annotations made on portions of a document containing printed text(col. 6, lines 1-36, Fig.4). Hull fails to explicitly disclose: *the summary includes expandable detail levels*. However, Bornstein teaches the increasing the sentences in a summary based upon the selection of a user-variable control (col.3, lines 16-40, col.4, lines 19-67, fig.3, 2). It would have been

obvious to a person of ordinary skill in the art at the time of the invention to combined Hull, and Bornstein, because of all the reasons found in Bornstein, including allowing a user to rapidly review a document based on the level of interest on such document (col. 2, lines 17-30).

Claim 16 is directed towards a method for implementing the apparatus found in claim 15, and therefore is similarly rejected.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hull, in view of Kupiec (Pat. # 6,533,822 B2, 3/18/03, filed on 1/30/98, as disclosed in pto-892 mailed on 8/25/04).

Claim 14 is directed towards a method for implementing the system found in claim 7, except that Hull fails to explicitly disclose *hidden portions, which are selectively expandable*. However, Kupiec teaches the generation of a summary along with indicators that indicate and display the location where extracted text was originally located (col.1, lines 26-67, fig.4). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hull, and Kupiec, because of all the reasons found in Kupiec, including avoiding the scanning of the whole document to find parts of the document that corresponding to portions of the summary (col.1, lines 14-67), and therefore is similarly rejected.

Allowable Subject Matter

14. Claims 4, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

15. Applicant's arguments filed 12/7/2007 have been fully considered but they are moot in light of the newly applied prior art. Regarding the pending claims, Applicants submit that the old prior art of record does not teach or suggest the remaining claims (pages 10-17). The Applicants are directed towards the rejection of these claims above in light of the newly found prior art, and the allowable subject matter.

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 2178

applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, please call 800-786-9199 or 571 272-1000 (USA or Canada).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- **(571)-273-8300** (for **all** Formal communications intended for entry)

/CESAR B PAULA/ Primary Examiner, Art Unit 2178

4/15/2009